Remarks

Claim 8 is amended herein for clerical reasons. Claims 1-26 remain pending in the Application. No new matter has been added due to the Amendments herein.

Rejection under 35 U.S.C. §101

In the present Office Action, Claims 1-26 are rejected under 35 U.S.C. §101 because the claimed invention is directed toward non-statutory subject matter.

On page 2, the Office Action states "[T]he Applicant's disclosure fails to describe the computer readable memory and database as being statutory types. As such, the claims are therefore non-statutory." Further direction is then provided to MPEP 2106.01.

Claims 1-9 and 22-26

On page 2, Claims 1-9 and 22-26 are rejected because the claimed data structure is disposed in a computer readable memory, which is not statutory.

Applicants respectfully disagree with the non-statutory statement. Applicants respectfully point out that MPEP 2106.01 clearly states

When _functional descriptive material is recorded on some computer-readable medium,_ it becomes structurally and functionally interrelated to the medium and _will be statutory_ in most cases since use of technology permits the function of the descriptive material to be realized. Compare _In re Lowry_, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (discussing patentable weight of data structure limitations in the context of a statutory claim to a data structure stored on a computer readable medium that increases computer efficiency) and _Warmerdam_, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a _specific data structure stored in memory_ held statutory product-by-process claim) with _Warmerdam_, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure _per se_ held nonstatutory). (emphasis added)

Applicants respectfully submit that data disposed in _a computer readable memory_ is indeed statutory as defined in the MPEP 2106.01. As such,

Applicants respectfully submit that the rejection of Claims 1-9 and 22-26 under 35 U.S.C. §101 is incorrect and should be withdrawn.

Claims 10-15

On page 2, Claims 10-15 are rejected because the claimed data structure is stored within a database but the database is not described within the specification as being of a statutory type of computer readable medium.

Applicants respectfully disagree with the non-statutory statement regarding a database. Moreover, Applicants respectfully disagree with the statement that the database is not described within the specification as being of a statutory type of computer readable medium. Applicants respectfully submit the use of "database" in the claim must be given their plain meaning. In other words, they must be read as they would be interpreted by those of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 218 USPQ 385 (Fed. Cir. 1983). Moreover, Applicants respectfully submit that the use of the term database in both the Claims and Specification is within the plain meaning of "database".

As previously stated, Applicants respectfully point out that MPEP 2106.01 clearly states

When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (discussing patentable weight of data structure limitations in the context of a statutory claim to a data structure stored on a computer readable medium that increases computer efficiency) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). (emphasis added)

Applicants respectfully submit that a database is a well known structure for storing computer-readable recorded material. As such, a database is statutory as defined in the MPEP 2106.01. For this reason, Applicants respectfully submit

that the rejection of Claims 10-15 under 35 U.S.C. §101 is incorrect and should be withdrawn.

Claims 16-21

On page 2, Claims 16-21 are rejected because the claimed data structure is not stored in a statutory computer readable storage medium.

Applicants respectfully submit that the rejection of Claims 16-21 under 35 U.S.C. §101 is incorrect and should be withdrawn. Specifically, Applicants respectfully submit that the preamble of Claim 16 clearly states "A network based method for selectively providing a data structure... to a client device".

According to Chapter 2100 of the MPEP:

Alappat, 33 F.3d at 1542, 31 USPQ2d at 1556.
**35 U.S.C. 101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent*>:< processes, machines, manufactures and compositions of matter. The latter three categories define "things" >or "products"<while the first category defines "actions" (i.e., inventions that consist of a series of steps or acts to be performed). See 35 U.S.C. 100(b) ("The term 'process' means process, art, or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material."). (emphasis added)

As such, Applicants respectfully submit that Claim 16 is statutory as it is a method for providing the data structure to a client device (emphasis added). Claims 17-21 depend on Claim 16 and provide further features. As such, Applicants respectfully submit that the rejection of Claims 16-21 under 35 U.S.C. §101 is incorrect and should be withdrawn.

Rejection under 35 U.S.C. §112

Claims 2, 10 and 22

In the Office Action, the Examiner rejected Claims 2, 10 and 22 under 35 U.S.C. §112, second paragraph, as being indefinite. "[T]he claims feature the term "selectively", which is indefinite."

Applicants respectfully submit that Claims 2, 10 and 22 recite features for selectively providing content to a client device. In addition, Claims 2, 10 and 22 include features which define the selection process, features such as "based on context relating to a user of said client device", and "wherein said context is subject to filtering".

Thus, Applicants respectfully submit that the term "selectively" is not indefinite, but in fact is a descriptive term used to describe a limitation on the content provide to a device. Moreover, Claims 2, 10 and 22 clearly provide the selective criteria.

For this reason, Applicants respectfully submit that Claims 2, 10 and 16 are not indefinite. As such the rejection of Claims 2, 10 and 16 under 35 U.S.C. §112, second paragraph, is incorrect and should be withdrawn.

Claims 4-5, 7, 9, 12-13, 15, 18-19, 21 and 23

In the Office Action, the Examiner rejected Claims 4-5, 7, 9, 12-13, 15, 18-19, 21 and 23 under 35 U.S.C. §112, second paragraph, as being indefinite. "[T]he claims feature the term "essentially", which is indefinite."

Applicants respectfully submit that Claims 4-5, 7, 9, 12-13, 15, 18-19, 21 and 23 recite the transitional phrase "consisting essentially of". The use of the "consisting essentially of" transitional phrase is clearly described in the MPEP including section 2111.03 Transitional Phrases [R-3].

Thus, Applicants respectfully submit that the term "essentially" is not indefinite, but is instead, a portion of a transitional phrase.

For this reason, Applicants respectfully submit that Claims 4-5, 7, 9, 12-13, 15, 18-19, 21 and 23 are not indefinite. As such the rejection of Claims 4-5,

7, 9, 12-13, 15, 18-19, 21 and 23 under 35 U.S.C. §112, second paragraph, is incorrect and should be withdrawn.

Claims 3, 11 and 17

In the Office Action, the Examiner rejected Claims 3, 11 and 17 under 35 U.S.C. §112, second paragraph, as being indefinite. "[T]he claims feature the phrase "device is activated and deactivated." It is not clear how a device can be activated and deactivated. Appropriate correction is required."

Applicants respectfully submit that Claim 3 (similarly Claims 11 and 17) recite the features "wherein said context changes dynamically in response to a condition relating to the temporal pertinence of said information with respect to said contextual information and wherein the receivability of said data structure to said client device is activated and deactivated in response to said condition" (emphasis added).

That is, Applicants respectfully submit that Claims 3, 11 and 17 do not describe the device being activated and deactivated. Instead, the Claimed feature clearly state "the receivability of said data structure to said client device is activated and deactivated" (emphasis added).

For this reason, Applicants respectfully submit that the rejection of Claims 3, 11 and 17 under 35 U.S.C. §112, second paragraph, is incorrect and should be withdrawn.

Claim 8

In the Office Action, the Examiner rejected Claim 8 under 35 U.S.C. §112, second paragraph, as being indefinite. "[T]here is insufficient antecedent basis for this limitation in the claim."

Applicants have amended Claim 8 herein to correct the clerical error. As such, Applicants respectfully submit that the rejection of Claim 8 under 35 U.S.C. §112, second paragraph, is moot.

<u>Rejection under 102(e)</u>

Claims 1-26

In the Office Action, Claims 1-26 are rejected under 35 U.S.C. §102(e) as being anticipated by Tahtinen et al. (2001/0046228). Applicants have reviewed Tahtinen et al. and respectfully state that Tahtinen et al. do not anticipate the present invention for the following rationale.

Applicants respectfully state that Independent Claim 1 (Independent Claims 10, 16 and 22 includes similar features), recites the features "A data structure disposed in a computer readable memory for providing information corresponding to a geographic location, said data structure comprising: a first data field for identifying said location; and a second data field associated with said first data field for containing said information, wherein a user can access said information" (emphasis added).

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." /Verdegaal Bros. v. Union Oil Co. of California/, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). ... "The identical invention must be shown in as complete detail as is contained in the ... claim." /Richardson v. Suzuki Motor Co/., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

Regarding Tahtinen et al., Applicants have reviewed Tahtinen et al. and do not understand Tahtinen et al. to teach or anticipate a data structure disposed in a computer readable memory for <u>providing information corresponding to a</u>

geographic location, said data structure comprising: a <u>first data field for</u> <u>identifying said location</u>; and a second data field associated with said first data field for containing said information, wherein a <u>user can access said information</u> (emphasis added).

Specifically, the present Office Action has incorrectly equated a virtual reality world of Tahtinen et al. with the geographic location of the present Claimed invention. However, Applicants respectfully submit that a geographic location is distinctly different than a virtual world location. Evidence of the distinction can be found throughout the Figures and Specification.

For this reason, Applicants respectfully submit that the features of Claims 1, 10, 16 and 22 are not anticipated by Tahtinen et al. As such, Applicants respectfully submit that the rejection under 102(e) is overcome and that Claims 1, 10, 16 and 22 are allowable.

Accordingly, Applicants also respectfully submit that Claims 2-9, 11-15, 17-21 and 23-26 are dependent on independent Claims 1, 10, 16 and 22 and that Claims 2-9, 11-15, 17-21 and 23-26 recite further features of the present claimed invention. Therefore, Applicant respectfully states that Claims 2-9, 11-15, 17-21 and 23-26 are allowable as pending from allowable base Claims.
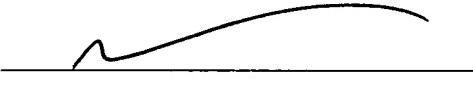
Conclusion

In light of the above amendments and remarks, Applicants respectfully request allowance of Claims 1-26.

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present application.

Respectfully submitted,

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